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EDWARD P DUTKIEWICZ P O BOX 511 LARGO, FL 33779-0511			SMITH, JAMES G	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/932,629

Filing Date: August 17, 2001

Appellant(s): LEE, HOWARD

Edward P. Dutkiewicz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 29 July 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: the first listed issue is a general statement of the grounds of rejection and the only points argued are issues 2 and 3.

(7) *Grouping of Claims*

The rejection of claim 1 is the only rejection of record.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,448,097

ROCCA

5-1984

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 stands finally rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons and Rocca.

Parsons shows the claimed invention except for the use of a bevel on the inner portion and the specific size proportions of the axial length of each portion. Rocca suggests that a driver with multiple, differently sized working portions can have a bevel at the juncture of the inner portion and the shaft, as well as between the inner and outer portions as one method of making the tool. It would therefore be obvious to one skilled in the art at the time the invention was made to modify Parsons by using a bevel at the juncture of the shaft and inner portion because Rocca suggests the use of such a bevel in a similar tool as one method of construction of such tools.

Conversely, Rocca shows a tool similar to that claimed and to Parsons except that the cross section is hex shaped instead of square. It would be obvious to modify Rocca by using a square cross sectional shape because Parsons suggests that when the fasteners have square shapes, the corresponding tools can be so shaped to engage this shape of fastener.

Further, to size any tool or part thereof to fit a desired need is an obvious modification to one skilled in the art.

(11) *Response to Argument*

Appellant claims a system that comprises a tool and a fastener. The tool comprises a shaft with two working portions, inner and outer, on one end and a handle

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on the other end. The outer portion is of a smaller size and shorter length than the inner portion. Both portions are square with the outer portion ending in a flat surface. The shape and size of both portions is dictated by the shape and size of the openings in the fastener so that the portions fit snugly into both openings. The claim also states that if the screw opening that is the outer most opening is of a smaller size, the outer portion of the tool can then engage this outer opening, thus one tool may be capable of engaging two differently sized fasteners. There is also a bevel at the juncture of the shaft and the inner portion of the tool. There is no stated function for the bevel in the application and from the attached Appendix B, it will never engage the fastener and therefore does not effect the operation of the tool.

Parsons shows a tool and fastener combination wherein the tool has a shaft (4) that ends in a working portion having an inner portion (10, 30, 40) and an outer portion (14, 34, 42) which engages into correspondingly shaped recesses within a fastener head. The various embodiments show that the inner portions (10, 30) have a square cross section and the portion (40) has a rectangular cross section. The outer portions all differ in that the portion (14) has a square cross section and a pointed face at the outermost end of the tool, the portion (34) has a flat face and the portion (42) has a curved face. The end faces of the portions (14) and (34) are so shaped to match the bottom surface of the inner recess of the fastener. Thus Parsons clearly shows a tool that can be matched to the shape and size of the recesses in a fastener. Appellant argues that with a pyramid or pointed shape face, the tool cannot be used to engage a smaller fastener, however he clearly admits that there is minimal contact and since the claim does not include a limitation to how much of the tool must engage a smaller

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fastener, the argument is not on point. The claim merely states that, if desired, the outer portion can be used to engage a smaller size recess in a smaller fastener, which from appellant's own Appendix B drawing, Parsons clearly can.

Appellant also argues that if the point where omitted along with its function, the result would be a "high quarter on invention", however there is no factual basis provided by appellant for this statement. Clearly one skilled in the art would know that Parsons contemplates the use of either a pointed or flat end face, thus the claimed limitation is clearly shown in Parsons. What is not shown is the use of the bevel between the shaft end and the inner working portion. Appellant has provided no statement as to the use of this construction and it can only be assumed that it is a result of the method of manufacture of the tool. The patent to Rocca, however, clearly shows that using bevels between adjacent portions of a tool is a well known method of manufacture of such tools and one skilled in the art would clearly be taught that a tool on the nature of the claimed tool or Parsons could be manufactured in this manner thus having a bevel at the various junctures. Appellant's argument that Rocca cannot be used with a fastener with two recesses is not on point as the reference is not used in the rejection to suggest such a method of use. It must be pointed out that any tool with two working portions that a shaped like those of Rocca would inherently be capable of functioning exactly like the claimed invention and Parsons.

Appellant also argues that neither Parsons nor Rocca show the claimed square flat cut face on the end of the tool to engage the bottom surface of the fastener. This is also in error as figure 6 of Parsons clearly shows that if desired, the end face can be made flat to engage a similarly shaped surface, in that same manner that figure 3

shows the end face to be pointed to engage a third recess instead of a flat bottom. What Parsons clearly shows in the embodiments of figures 3 and 6 is that it is desirable to engage a bottom portion of the fastener, and that the tool must have the same shape as that bottom surface to perform this function. This is exactly what appellant claims. Further, Rocca show a flat end face and if used to engage a double recess fastener head, it will also engage a flat bottom. The square cross sectional shape is also clearly shown in figures 2-4 of Parsons.

Appellant also argues on page 8 of the brief that even if the rejection where correct in assuming a teaching, "the resulting structure would still fail to anticipate applicant's invention", however this is in error as there is no rejection of claim 1 as being anticipated by any reference. The rejection is only one of obviousness.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner
Art Unit 3723

jgs
September 16, 2004

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